

REMARKS

In accordance with the foregoing, claims 1, 3-15, 17, and 18 are pending and under consideration.

Rejection of Claims 1, 3-15, 17, and 18 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1, 3-15, 17, and 18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,392,977 issued to Ando et al. (hereinafter referred to as "Ando") in view of U.S. Patent 5,659,531 issued to Ono et al. (hereinafter referred to as "Ono") and the admitted prior art.

Ando, Ono, and the admitted prior art, taken separately or in combination, do not disclose, teach, or suggest at least, "beam splitter having ... a second surface on which a hologram is formed to compensate for a deviation between optical axes of the first and second light beams transmitted through the first surface," as recited in independent claim 1.

In item 4, the Office Action states, "the Ono et al. reference was relied upon to teach a missing feature of claim 1, i.e., a beam splitter having a surface on which a hologram is formed."

The Office Action also asserts,

"The Ono et al. reference teaches (see last three lines of abstract) that the polarizing beam splitter having a hologram enables to make an optical head device that is compact, light in weight, and low cost. The admitted prior art (see paragraph 0004) teaches that using a dual wavelength laser diode including both a laser diode for DVDs and a laser diode for CDs decreases the number of parts used to manufacture optical pickup apparatuses. Therefore, there is a suggestion to combine Ando et al. with Ono et al. and the admitted prior art."

These assertions are respectfully traversed. In col. 7, lines 36-59, Ono discloses a hologram element 216 shown in Figure 11A. More specifically, col. 7, lines 40-43 discloses, "The hologram element 216 is configured such that the back surface thereof constitutes the birefringent diffraction grating polarizer of a reflection type,..." Accordingly, Ono's hologram is formed so that beams reflected from optical disk 214 are diffracted (col. 7, lines 36-59 of Ono).

However, Ono does not disclose any compensation for a deviation between optical axes of the first and second light beams transmitted through the first surface. Therefore, Ono does not disclose, teach, or suggest at least, "beam splitter having ... a second surface on which a

hologram is formed to compensate for a deviation between optical axes of the first and second light beams transmitted through the first surface," as recited in claim 1.

Further, to set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

"Rejection of patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)(vacating a decision by The Board of Patent Appeals and Interferences ("Board") of the USPTO, which upheld an examiner's rejection where the motivation for a specific combination was not supported by the record; the vacated holding of Board was based on the premise that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.")

The mere fact, however, that the prior art may be modified in the manner suggested in the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Accordingly, neither Ando nor Ono suggests that Ono's beam splitter (Figure 11A, element 216) could be utilized in Ando's system. Neither Ando nor Ono proposes substituting Ono's beam splitter for Ando's beam splitter 7 and Ando's dichoric hologram 8. Instead,

With respect to the admitted prior art, the admitted prior art does not cure the

deficiencies of Ando and Ono. In addition, Applicants note that the Office Action does not assert that the admitted prior art teaches this feature.

In addition, Applicant respectfully submits that "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

Therefore, for at least these reasons, claim 1 is patentably distinguishable from the cited references.

Claims 3-9, and 18 depend from claim 1 and include all of the features of claim 1. Therefore, for at least these reasons, claim 1 is patentably distinguishable from the cited references.

Similarly, Ando, Ono, and the admitted prior art, taken separately or in combination, do not disclose, teach, or suggest at least, "wherein a hologram is formed on the second surface to compensate for a deviation between optical axes of the emitted light beam and the second light beam, which are transmitted through the first surface," as recited in claim 10. Therefore, for at least these reasons, claim 10 is patentably distinguishable from the cited references.

Claims 11-14 depend from claim 10 and include all of the features of claim 10. Therefore, for at least these reasons, claim 10 is patentably distinguishable from the cited references.

Similarly, Ando, Ono, and the admitted prior art, taken separately or in combination, do not disclose, teach, or suggest at least, "beam splitter having ... a second surface which receives the first and second light beams reflected from the recording medium, to compensate for a deviation between optical axes of the first and second light beams transmitted through the first surface," as recited in claim 15. Therefore, for at least these reasons, claim 15 is patentably distinguishable from the cited references.

Claim 17 depends from claim 15 and includes all of the features of claim 15. Therefore, for at least these reasons, claim 17 is also patentably distinguishable from the cited references.

Accordingly, withdrawal of this rejection is respectfully traversed.

Accordingly, withdrawal of this rejection is respectfully traversed.

Summary

Claims 1, 3-15, 17 and 18 are pending and under consideration. It is respectfully submitted that none of the references taken alone or in combination disclose the present claimed invention.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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